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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 715,294	11 17 2000	Narendra S. Yadav	CL1127 US CIP1	5868

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EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,294

Applicant(s)

YADAV, NARENDRA S.

Examiner

Ashwin Mehta

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-80 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 4-31, 33-35, drawn to a trait removal construct comprising a first and second recombinase elements comprising a recombinase coding sequence; method for removing a transgene encoding a genetic trait from a plant cell, classified in class 435, subclass 320.1, for example.
- II. Claims 2, 4-31, 33-35, 70, and 80, drawn to a trait removal construct comprising a first and second recombinase elements and two recombinase coding sequences; a method for removing transgene from a plant cell classified in class 435, subclass 468, for example.
- III. Claims 3, 4-35, 70, and 80, drawn to a construct comprising three recombinase elements; a method for removing a transgene from a plant cell, classified in class 435, subclass 419, for example.
- IV. Claims 36-43, 70, and 80, drawn to a method for conditionally activating a transgene in a second generation plant, classified in class 800, subclass 278, for example.
- V. Claims 44-51, 53, 70, and 80, drawn to a method for conditional and transient expression of a trait transgene, classified in class 800, subclass 291, for example.
- VI. Claim 52 and 54, drawn to a method for expressing conditional male sterility in first and second generation plants, comprising providing four recombinase elements, classified in class 800, subclass 303, for example.

VII. Claims 55-67, drawn to a method for transgene removal, classified in class 800, subclass 290, for example.

VIII. Claims 68 and 69, drawn to a method for conditional gametophytic expression of male sterility, classified in class 435, subclass 440, for example.

IX. Claims 71-79, drawn to a method for developmentally regulated germline expression of a transgene, classified in class 80, subclass 278, for example.

Claims 4-31, 33-35, 70, and 80 will be examined to the extent that they read on the elected invention.

The inventions are distinct, each from the other because of the following reasons:

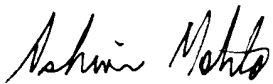
Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and effects. The constructs of Groups I-III are different from each other and are not required by their respective methods. The methods resulting in trait removal of Groups I, II, and III are not required by the methods resulting in transgene activation of Groups IV, V, VI, and VIII. The constructs of Groups IV, V, VI, and VIII are different from each other and are not required by their respective methods. The method for developmentally regulated germline expression of Group IX does not require the recombinase coding sequences of the other groups.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-IX, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

March 25, 2002


ASHWIN D. MEHTA, PH.D.
PATENT EXAMINER